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09/925,333	08/09/2001	Thomas Mammone	01.38US	4422

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EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/925,333
Filing Date: August 09, 2001
Appellant(s): MAMMONE ET AL.

Cynthia R. Miller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 November 2006 appealing from the Office action mailed 25 April 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-7, 10-14 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson (US Patent No. 5,520,926, already of record).

Appellant claims a method of exfoliating the skin comprising applying to the skin a composition containing an effective amount of a mannose phosphate. Appellant also claims a method for increasing levels of glycosaminoglycans in skin comprising applying to the skin a composition containing an effective amount of a mannose phosphate. Appellant further claims a method of treating a skin condition associated with a reduced level of glycosaminoglycans in the skin comprising applying to the skin afflicted with such a condition a composition containing an effective amount of a mannose phosphate. Additional limitations in the dependent claims include the mannose phosphate being mannose-6-phosphate, the use of a specific amount of mannose phosphate, and the method having specific skin conditions, which include dry skin, lines and wrinkles, and symptoms of chrono- and photoaging.

The Ferguson patent discloses mannose 6- and 1-phosphates as being useful in the treatment of fibrotic disorders (see abstract). See column 4, lines 28-31, wherein the Ferguson patent discloses the invention thereof as being "primarily of interest in relation to skin wounds, whether arising through surgery or other wise, including severe abrasions laceration and burns, but is also applicable to fibrotic disorders, which includes photo-damage." See the examples disclosed in the Ferguson patent wherein the amounts of mannose phosphates used in the treatments are disclosed, which appear to be within the scope of the amounts of mannose phosphate set forth in the

instant claims. The use of mannose phosphate to treat fibrotic disorders, which includes photo-damage skin, in the Ferguson patent anticipates the instantly claimed method of increasing levels of glycosaminoglycans in skin, since the instant claims disclose that photoaging of skin is a condition associated with reduced level of glycosaminoglycans in the skin (see instant Claim 14). The application of mannose phosphate for the treatment of skin disclosed in the Ferguson patent also anticipate the subject matter of instant Claim 1 wherein mannose phosphate is applied to the skin in a method of exfoliating the skin.

(10) Response to Argument

Appellant's arguments filed November 13, 2006 in the Appeal Brief have been fully considered but they are not persuasive. Appellant argue against the rejection on the ground that that the Examiner's position regarding "photoaging" as the term is used in the art generally, and in the present specification, and "photodamage" as it relates to the Ferguson patent, is incorrect. This argument is not persuasive in view of the Journal of American Academy of Dermatology, 1996; Vol. 35, pages 462-464, which is titled "Guidelines of Care for Photoaging/Photodamage". In this article under subheading "II. Definition", the article discloses that "photoageing and photodamage (dermatoheliosis) are terms used interchangeable to described those chronic changes in the appearance and function of the skin caused by repeated sun exposure". In this session of the article it is disclosed that "photodamage may be chronic or acute and that acute photodamage is a sunburn". The article continue on to disclose that "overwhelming epidemiologic and laboratory evidence indicates that sun exposure and other sources of UV radiation (UVR) play the major role in causing the undesirable skin changes of fine and coarse wrinkles, roughness, laxity, mottled pigmentation, actinic lentigines, actinic keratoses, leathery texture/coarseness, scaling/xerosis, sallowness, and telangiectasia." This article presented by the American Academy of Dermatology shows that the teachings disclosed in the Ferguson patent and in the instant application

Art Unit: 1623

are not distinct, and that the terms "photodamage" and "photoaging" are not mutually exclusive conditions.

The Journal of American Academy of Dermatology article is not being used to reject the instant claims (not being used to present a new ground of rejection). This article is only intended to assist in rebutting Appellant's arguments.

Appellant also argue that *In re Spada* and MPEP 2112.01 has been misapplied to the present claims since the instant claims are directed to a process. This argument is not persuasive since the instantly claimed inventions only disclosed a process step that involve the administration of the product (mannose phosphate) to the skin, in order to accomplish the limitations recited in the preambles of the instant claims. No multiple process steps are recited in the instant claims, which means that the mannose phosphate is only required to have the properties disclosed in the preambles of the instant claims. The Ferguson patent, which does disclose the administration of mannose phosphate to the skin, does indeed have the properties recited in the preamble of the instant claims, since the mannose phosphate of the Ferguson patent and cited in the instant claims are substantially the same. Perhaps, Appellant may have a greater appreciation for *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986), which states - Under the principles of inherency, if a prior art device (in the instant case, mannose phosphate), in its normal and usual operation (in the instant case, administered to the skin), would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process.

Appellant further argue that the skin to which a mannose phosphate would be applied according to the reference (skin exhibiting wounds or fibrotic disorders) is not the same skin to which a mannose phosphate would be applied according to the methods of the present invention (dry and/or wrinkled skin associated with aging). It is

Art Unit: 1623

noted that instant Claim 14 is the only claim that specifically recites the skin condition – dry, lines and wrinkles, and the symptoms of chrono- and photoaging. This argument is not persuasive since the Ferguson patent discloses administration of mannose phosphate to treat skin conditions that include severe burns and photo-damage (see column 4, lines 28-31), which falls within the scope of the skin conditions disclosed in instant Claim 14.

Appellant also argue that the method of exfoliating skin disclosed in instant Claims 1 and 4-6 is distinct from the methods disclosed in the Ferguson patent and the instant claims drawn to methods of increasing levels of glycosaminoglycans in skin and treating a skin condition associated with a reduced level of glycosaminoglycans by describing the population of users in instant Claims 1 and 4-6 as having "flakey" skin. This argument is not persuasive since the method of Claims 1 and 4-6 does not require the skin to be flakey.

Appellant further argues that "a method of exfoliating the skin (e.g. treating flakey skin) is not the same as the treatment of skin wounds or tissue exhibiting fibrotic disease." It appears that Appellant is attempting to insert a new definition of "exfoliation" that is not supported by the specification. Again, the claims merely require the application of mannose phosphate to skin--any skin, in the case of claims 1 and 4-6 or "photoaged" skin, in the case of claims 7, 10-14 and 17-19. There is no requirement that the skin in question be "flakey." Therefore, the application of mannose phosphate to photoaged skin, as taught by Ferguson, anticipates the instant claims.

(11) Related Proceeding(s) Appendix

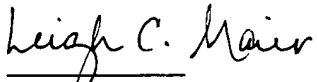
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

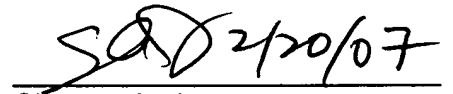
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Everett White

Conferees:


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